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QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C.

By: *Evelyn Gomez*
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Appl. No. : 10/038,001 Confirmation No. 5532

Applicant : Kenneth E. Palmer, et al.

Filed : December 20, 2001

TC/A.U. : 1636

Examiner : Gerald G. Leffers Jr.

Docket No. : 60-017910US

Customer No. : 22798

Client Ref No.: 0179-CPUS01

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement mailed October 23, 2003, Applicants elect to prosecute Group 1 (claims 1-26) without traverse.

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Respectfully submitted,

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ATTORNEY DOCKET NO. 14014.0349U2
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
Blackshear *et al.*) Group Art Unit: 1634
)
Serial No. 10/049,586)
) Examiner: Sisson, B. L.
)
Filed: February 12, 2002)
) Confirmation No. 9700
For: TTP-RELATED ZINC FINGER DOMAINS)
AND METHODS OF USE)

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

NEEDLE & ROSENBERG, P.C.
Customer No. 36339

December 11, 2003

Sir:

In response to the Restriction Requirement issued July 30, 2003 for the above-referenced patent application, applicants provisionally elect Group IV (claims 53-61, drawn to a method of identifying a compound that modulates the activity of TTP or a TTP-like polypeptide), with traverse.

It is believed the common inventive step has been misstated. The Examiner states that "the inventions are linked through the common technical feature of TTP, however, TTP was known in the art prior to the filing of the subject application." However, the common technical feature is much more specific than just the TTP molecule. The common concept linking the claims is the finding that TTP causes degradation of mRNA via binding to the ARE. Applicants would like to draw the Examiner's attention to the claims. All of the claims teach limitations which are not found in the art of WO 97/42820. Claims 39-63 teach not only TTP, but a nucleic acid that comprises an ARE, which is not taught in the above-mentioned art. Furthermore, claim 64 teaches a polypeptide consisting essentially of a TTP zinc finger domain or a TTP-like zinc

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finger domain. This polypeptide also interacts with ARE, and is novel and unobvious with regard to the prior art. Therefore, the claims do relate to a single inventive concept under PCT Rule 13.1.

Furthermore, Applicants request that the restriction requirement be reconsidered because it has not been shown that a serious burden would be required to examine all the claims.

M.P.E.P. § 803 provides:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis added.*)

Thus, for a restriction requirement to be proper, the following two criteria must be satisfied: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) that search and examination of the entire application cannot be made without serious burden. *See* M.P.E.P. § 803.

However, it has not been shown that the second requirement has been met, i.e., that it would be a serious burden to search and examine the groups together. In particular, restriction groups I, II, IV and V are drawn to methods of screening and identifying agents for their ability to interact with or mimic TTP. More particularly, any search for group IV would require searching for interactions between the zinc finger region of TTP and an ARE of mRNA. Since such a search would also identify any art relevant to the other groups, no additional burden is required to examine all of the groups together. Because little or no additional burden would be required to search and examine the groups together, applicants respectfully submit that the groups should be searched and examined together. For these reasons, reconsideration and withdrawal of the restriction requirement is requested.

For the reasons stated above, applicants respectfully assert that restriction of the claims as set forth in the present Office Action would be contrary to promoting efficiency, economy and expediency in the U.S. Patent and Trademark Office and further point out that requirements for

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restriction under 35 U.S.C. § 121 are discretionary (M.P.E.P. § 803.01). Therefore, applicants respectfully request that all of the claims of this application be examined together. Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested.

Credit Card Payment Form PTO-2038 in the amount of \$1,480.00 (extension of time fee) and a Request for Extension of Time are enclosed. No additional fees are believed to be due; however, the Commissioner is hereby authorized to charge any fees that may be required or to credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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Gwendolyn D. Spratt

12-11-03

Date